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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,721	01/10/2001	Ursula Murschall	00/001 MFE	8369
38263	7590	10/19/2004	EXAMINER	
PROPAT, L.L.C. 425-C SOUTH SHARON AMITY ROAD CHARLOTTE, NC 28211-2841			UHLIR, NIKOLAS J	
			ART UNIT	PAPER NUMBER
			1773	
DATE MAILED: 10/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/757,721

Applicant(s)

MURSCHALL ET AL.

Examiner

Nikolas J. Uhler

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment/arguments dated 08/09/2004. Currently, claims 1-19 are pending.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-4, 6-12, and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peiffer et al. (US5955181) in view of Oishi et al. (US5936048) and Rogers et al. (US5804626).

4. The rejection of claims 1-4, 6-12, and 14-17 is maintained as set forth in the previous office action dated 4/12/04, except for the following modification. The limitation, "said film thus further comprising predried and/or precrystallized masterbatch carrier polymer" in claim 1 is a process limitation in a product claim and does not appear to be further limiting insofar as the structure of the product is concerned. While products are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP § 2113.

5. The examiner notes that the limitation, "said film thus further comprising predried and/or precrystallized masterbatch carrier polymer" appears to require

Art Unit: 1773

the final product to contain predried or precrystallized masterbatch copolymer. However, the claim does not require the carrier polymer to be different from that of the polyester film itself, and the final product is a *biaxially oriented film*. Thus, while the precursor to the biaxially oriented film may contain predried or precrystallized masterbatch polymer, the final product will not, because the precursor to the final product must be melted prior to extrusion. Thus, it is the examiners position that any crystalline polymer present in the precursor will not be present in the final product, as applicant has provided no evidence, which establishes that the process by which the product is made has any impact on its structure.

Regarding new claim 18. The total thickness of the polyester film of Peiffer is preferably 5-30 μ . Thus, applicant's thickness limitation is met. Applicant flame retardant requirement is met as set forth above for claims 1-4, 6-12, and 14-17.

6. Regarding the requirement that the material pass the requirements for construction material classes B2 and B1 to DIN 4102, the examiner takes the position that this property will flow naturally from the combination of Peiffer with Oishi and Rogers as set forth above. This combination results in a polyester film having substantially the same structure and composition as that of the instantly claimed polyester film. Thus, it is logical to believe that this limitation is met.

7. Claim 19 requires a transparent biaxially oriented film comprising polyester consisting essentially of polyethylene terephthalate and at least one flame retardant, said flame retardant incorporated as a predried and/or precrystallized masterbatch, said film thus further comprising predried and/or

Art Unit: 1773

precrySTALLIZED masterbatch carrier polymer, wherein said transparent film does not embrittle when exposed to temperatures of 100°C for 100 hours.

8. The examiner interprets the limitations relating to the masterbatch process and carrier polymer in the same manner as set forth in the previous office action and above at sections 3-4 of this office action. Further, MPEP 2111.03 states:

" The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original)... **For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising."**

With the MPEP's instructions in mind, the examiner finds that the basic and novel characteristic of the claimed invention is the lack of embrittlement of a polyester after the polyester has been held at 100°C for 100 hours. Thus, the examiner interprets the limitation "consisting essentially of polyethylene terephthalate" as requiring a biaxially oriented film of polyester, wherein the polyester must contain polyethylene terephthalate, and is allowed to contain any other components that do not materially impact the embrittlement property of the polyester.

9. Bearing the above interpretation in mind, the examiner notes that the biaxially oriented polyester of Peiffer comprises three layers, wherein the innermost layer comprises polyethylene terephthalate (PET), and the outer layers comprise a copolymer of polyethylene naphthalate (PEN) and PET (column 4, line 9-column 5, line 31). The ratio of PEN to PET in the outer layers is in the range of 5/95-95/5.

Art Unit: 1773

10. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a copolymer comprising 95% PET and 5% PEN as the outer layers of Peiffer as modified by Oishi and Rogers, as Peiffer recognizes the equivalence of this copolymer blend to the others listed as suitable.

11. It is the examiners position that a copolymer blend comprising 5% PEN and 95% PET, consists essentially of PET. Applicant has provided no evidence that the presence of 5% PEN in an otherwise pure PET film will materially impact the embrittlement properties of the film.

12. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peiffer as modified by Oishi and Rogers as applied to claims 1-4, 6-12, and 14-17 above, and further in view of Murschall (DE19630599).

13. This rejection is maintained as set forth in the prior office action dated 4/12/04.

Response to Arguments

14. Applicant's arguments filed 08/09/2004 have been fully considered but they are not persuasive. First applicants argue that the embrittlement resistance of the instantly claimed polyester films is an unexpected result that arises from the process by which the polyester film is made. In particular, applicants "submit that this lack of embrittlement is most probably attributable to synergy relating to the recited predrying and/or precrystallization."

15. This argument is not persuasive. Applicants have provided no evidence that establishes that the asserted improvement in the embrittlement

Art Unit: 1773

characteristics of the claimed film result from the process by which the film is made. The examiner cannot consider applicants assertion that this improvement "most probably" attributable to synergy relating to the recited process to be persuasive evidence establishing the claimed property as an unexpected result arising from the asserted process. A mere assertion that something "most probably" arises from something else, without supporting that assertion with data is nothing more than an uncorroborated self serving statement, and is not considered to be persuasive.

16. Applicants then argue that there would have been no motivation to make the combination of references in the manner suggested by the examiner, and that the examiner is using improper hindsight by picking and choosing elements from the prior art while using applicants specification as a guide.

17. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case there is clear motivation to make each of the asserted modifications to Peiffer. These motivations are clearly expressed above and in the prior office action dated 4/12/2004 (see specifically sections 10, 15, 25, 31, and 34). All of these

motivations came expressly from the prior art, not applicant's specification.

Hence, this argument is unpersuasive.

18. Applicant then argues that even if the references could be combined in the manner suggested, they still wouldn't teach the invention, because none of the reference teach the recited masterbatch process. The examiner acknowledges that the references do not teach the recited process. However, the examiner maintains that the process by which the instant polyester film is made does not impact the structure and properties. The patentability of a product is predicated on the product itself, not the manner in which it is made. Applicant has provided no evidence to refute the examiners assertion that the claimed properties are not a result of the process, but rather are necessarily met by a polyester film having the same composition and structure as that of the instantly claimed film. Merely asserting that the prior art and the claimed invention are different because the prior art is not made by the same process is not a persuasive argument absent conclusive evidence that supports such an assertion.

19. The remainder of applicant's arguments are directed towards what each reference individually fails to teach. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Thus, these arguments are unpersuasive.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolas J. Uhlir whose telephone number is 571-272-1517. The examiner can normally be reached on Mon-Fri 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1773

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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D. S. NAKARANI
PRIMARY EXAMINER